

Remarks

Claims 1-2, 4-6, 8-12, 14 and 17-19 are pending.

All pending claims stand rejected under Section 102(e) as being anticipated by Czysczewski (6867876). The Examiner has rejected the Rule 131 Declaration of inventor Keith Braunwalder, arguing it is not sufficient to remove Czysczewski as a prior art reference because (1) the Declaration is not signed by both inventors and (2) it does not establish invention of the claimed subject matter.

The Signature Of An "Unavailable" Inventor Is Not Required (MPEP 715.04)

As presented in the Response to the prior Office Action, which is repeated here, according to the MPEP the signature of all inventors is required on a Rule 131 Declaration unless an inventor is not available.¹ MPEP 715.04 states that "where it is shown that the joint inventor is deceased, refuses to sign, *or is otherwise unavailable*, the signatures of the remaining joint inventors are sufficient." (emphasis added) Mr. Braunwalder states in paragraph 1 of his Declaration that his co-inventor, Jeffrey Aguilera, "is no longer employed by Hewlett-Packard Company and, therefore, he is not available to assist with this Declaration." It has been shown, therefore, that inventor Aguilera is unavailable. The signature of the remaining inventor, Keith Braunwalder, is sufficient.

Similar rule 131 declarations have been submitted by the undersigned without objection in other patent applications owned by Hewlett-Packard Company in which one of the inventors has left the company.² This factual scenario is hardly unusual. If the Patent Office is now taking the position that Hewlett-Packard Company is required to track down former employee inventors in an effort to get them to sign Rule 131 Declarations, then it should explicitly say so and provide the legal basis for imposing this substantial burden. Presumably, the Patent Office will have then imposed this

1 35 C.F.R. 1.131 (Rule 131) states that the "inventor" may submit a declaration to establish invention. The Patent Office has interpreted "inventor" in MPEP 715.04 to mean all inventors. While the Code of Federal Regulations may have the force of law, the MPEP does not. The Examiner's suggestion to the contrary is not correct. The Applicant, however, is not now challenging the Office's interpretation of Rule 131.
2 E.g., 09/483,617 and 10/142,103.

same burden on *all* corporate assignees for *every* rule 131 Declaration in which one of the inventors is no longer employed by that assignee. If this is not the official position of the Patent Office, then the Examiner should withdraw this objection to Mr. Braunwalder's Declaration.

The Invention Disclosure Document Shows The Claimed Subject Matter

The Examiner's remarks supporting the rejection of the Declaration as not sufficient to establish invention of the claimed subject matter are quoted below.

"In the Exhibit 1, the Applicants have not clearly show in details how to solve the problem as stated in claims 1 and 14 of the application; and nowhere in the Exhibit 1 mentions a duplicator, selectable icons, and selectable menu items. Claims do not appear to be supported by the evidence provided in claims. It means that there is not enough evidence to clearly prove the relationships between the Exhibit 1 and the Claims." Office Action page 7.

The correspondence between the elements of the independent claims and the Invention Disclosure document (Exhibit 1 to the Braunwalder Declaration) was detailed in the prior response under the heading *Mapping The Claimed Subject Matter To The Invention Disclosure*. In general, Applicants note again that Fig. 1 in the Invention Disclosure is nearly identical to Fig. 3 in the patent Application, which illustrates one embodiment of the user interface of Claims 1 and 10. The specific items mentioned by the Examiner are noted below.

Duplicator -- Fig. 1 to the Invention Disclosure shows a user interface (UI) for an HP Digital Workplace Copier as indicated in the extreme upper left hand corner of the UI. Of course, a digital copier is a duplicator.

Selectable icons -- The top part of the UI in Fig. 1 includes selectable icons (Copies, Reduce-Enlarge, Contrast and Copy Quality) for a first duplicator, the HP Digital Copier. The bottom part of the UI includes selectable icons (I want to print to another printer, Name and Color) for a second duplicator (an HP printer is selected).

Selectable menu items -- the UI of Fig. 1 of the Invention Disclosure is itself a menu page displaying selectable menu items such as the Number of Copies, size of the copies (standard and custom sizing), Contrast (lighten or darken) and Copy Quality (photo, text, draft).

The Examiner is urged to again review the full discussion mapping the claim elements to the Invention Disclosure from the prior Response.

Finally, with regard to the Examiner's statement that Applicants "have not clearly show in details how to solve the problem as stated in claims 1 and 14....", Applicants note first that the claims do not state a problem, and second, that Rule 131 does not require any showing related to solving problems. Applicants are required only to "establish invention of the [claimed] subject matter....", which they have done.

If the Examiner continues to feel the Applicants have failed to establish "invention of the claimed subject matter" as required, then he is respectfully requested to specifically point out **and explain** those elements from the independent claims that do not appear in Fig. 1 of the Invention Disclosure (Exhibit 1 to the Braunwalder Declaration) and afford the Applicants a fair opportunity to respond.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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